

## REMARKS

Applicant has canceled claims 32-36.

Claims 1-3, 15-17 and 26-31 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Paley et al. (US 4,888,229) in view of Meitner et al. (4,493,868). The Examiner has taken the position that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the wiper of Paley and provide it with a discontinuous fused zone allegedly taught by Meitner, motivated by the desire to produce "an area with aesthetically pleasing appearance and with physical properties and characteristics approaching those characteristics of textile materials as disclosed by Meitner."

Applicant respectfully submits that all of claims 1-3, 15-17 and 26-31, as amended, include the limitation of a "discontinuous fused zone," and that the Paley reference teaches away from a discontinuous fused zone. The Paley reference teaches a wiping cloth having a continuous fused border in the material along the peripheral edges of the wiper and extending inwardly into the wiper a distance great enough to provide the fused border with sufficient area and sufficient tear-strength to maintain therein segments of the material of the wiper which otherwise might be released from the peripheral edges of the wiper during use of the wiper, yet small enough to maintain pliability and absorbency in the wiper for wiping procedures. (See abstract and Fig. 1). The Paley reference states that the fused border extends inwardly from the periphery, in order to seal any severed segments or fibers, thus preventing their release during use of the wiper. (Column 3, lines 29-33). This reference even includes a formula requiring that the

continuous fused border extend inwardly a distance D, which is chosen so as to be large enough to capture all of the severed segments, which otherwise could be free to escape into the ambient atmosphere and contaminate the controlled environment with which the wiper is used. (Column 3, lines 34-53).

In view of these teachings, Applicant respectfully submits that the Paley reference teaches away from the use of a discontinuous fused zone. Indeed, column 3, lines 13-19 state, in pertinent part "... however, experience has shown that the localized melting of the segments is insufficient to prevent the segments from release when subjected to agitation and other manipulations common in the use of the wiper."

Further, Applicant respectfully submits that the Meitner reference constitutes non-analogous art with respect to the instant claims.

"The test as to whether two references are from nonanalogous arts is whether one seeking to solve a problem with respect to the embodiment of a reference in one art would be apt to seek the solution to said problem in the other art." *In re Shapleigh*, 248 F.2d 96, 102, 115 USPQ 129, 133 (CCPA 1957).

In the instant case, the claims are directed to a wiper suitable for use in a cleanroom environment, having substantially stable edges that do not undergo substantial particulate generating fracture upon application of tensile stresses applied during normal use. (See Summary of the Invention in the instant application). Applicant respectfully submits that one seeking to solve this problem would not seek the solution in the Meitner reference, which is directed to solving the problem of improving non-wovens and their manufacture to achieve a high degree of bulk and other desirable textile-like properties.

(See column 1, lines 40-43 of the Meitner reference). These problems, and the solutions proposed, are wholly unrelated to one another.

The Federal Circuit has adopted a two-step test for determining whether cited references properly fall within the scope of the art in *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). First, the reference must be "within the field of the inventor's endeavor." Second, if the reference is outside that field of endeavor, it must be "reasonably pertinent to the particular problem with which the inventor was involved." In this case, the reference is neither within the field of the inventor's endeavor, as set forth above, nor is it reasonably pertinent to the particular problem with which the inventor was involved.

"A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it. *In re Clay*, 966 F.2d at 659-60, 23 USPQ2d at 1961 (Fed. Cir. 1992).

Claims 4, 18, 23-25, and 32-36 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Paley et al. and Meitner et al. in view of Morin et al (US 6,189,189). Applicant has canceled claims 32-36. Applicant respectfully maintains that the Paley reference teaches away from the use of discontinuous borders, and that the Meitner reference is non-analogous art, as set forth above.

Further, Applicant respectfully submits that the suggestion that the claimed invention is obvious in light of the above references is improper based on hindsight. Court decisions criticizing improper use of hindsight are legion:

“[D]ecomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis.” *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 28 USPQ2d 1801 (N.D. Ill. 1993).

Claims 5-14 and 19-22 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Paley et al., Meitner et al., Morin et al., further in view of Dean et al., and Rockwell. Apparently the Examiner believes that it would be obvious for one skilled in the art at the time the invention was made to combine elements from this multitude of cited references, resulting in Applicant's claimed wiping cloth. Applicant respectfully maintains that the Paley reference teaches away from the use of discontinuous borders, and that the Meitner reference is non-analogous art, as set forth above. Moreover, the suggestion that it would be obvious to combine prior art references in order to support a 103 rejection becomes less plausible when the necessary elements can only be found in a large number of references.

Applicant respectfully submits that the Examiner has not shown any teaching within the references to combine elements in the manner suggested by the Examiner. Combining reference teachings is improper unless the prior art contains some suggestion of the proposed combination.

The motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. See *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination."); accord *In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989) ("[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification") (quoting *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)); *Sentex Systems, Inc. v. Elite Access Systems, Inc.*, 1999 U.S. App. LEXIS 3846 at \*17 ("to invalidate claimed subject matter for obviousness, the combined teachings of the prior art references must suggest, expressly or by implication, the improvements embodied by the invention.").

"[T]he PTO erred in rejecting the claimed invention as an obvious combination of the teachings of two prior art references when the prior art provided no teaching, suggestion or incentive supporting the combination." *In re Bond*, 910

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F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). "[A] challenger to the validity of a patent 'cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention;' the challenger 'has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination.'" *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988).

Accordingly, Applicant respectfully submits that the claims are now in condition for allowance, and such action is respectfully requested.

Respectfully submitted,



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